

Response to Office Action
Page 2 of 6

Atty. Dkt. AZMT/002P1
Serial No. : 10/730,758

REMARKS

In the April 4, 2005 Office Action, the Examiner rejected Claims 1-11 and acknowledged the withdrawal of Claims 12-14 in the previous Response to Restriction Requirement. By this Response, all rejected claims continue unamended and arguments refuting the Examiner's positions are provided. In view of the following discussion, the Applicant submits that none of the claims now pending in the application are obvious under the provision of 35 U.S.C. §103 or rejected for reasons of double patenting. Accordingly, the Applicant requests that the Examiner enter this Response and reconsider the application.

REJECTIONS

Rejection of claims – Nonstatutory Double Patenting

The Examiner has rejected Claims 1, 2 and 4-6 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1-3, 6, 8, and 10 of US Patent No. 6,660,562. The rejection is respectfully traversed.

Specifically, the reference identified by the Examiner is a patent that matured from the parent application (Serial No. 09/998,454) of the subject application. Such parent application data was identified in the Cross-Reference to Related Applications section of the subject application. The cited reference and subject application share the same inventive entity (David Lee) as well common ownership to Azimuth Industrial Co., Inc. Note that the subject application was assigned to Azimuth Industrial Co., Inc. by recordation of an assignment on May 10, 2004 at Reel 014613, Frame 0284. As such, a properly executed Terminal Disclaimer is included with this Response to remove any alleged improper timewise extension of the "right to exclude". Accordingly, it is respectfully submitted that the rejection of Claims 1, 2 and 4-6 under the doctrine of obviousness-type double patenting is deemed moot and withdrawal of the rejection is respectfully requested.

11427-1

Response to Office Action
Page 3 of 6

Atty. Dkt. AZMT/002P1
Serial No. : 10/730,758

Rejection of Claims under 35 U.S.C. § 103 - Claims 1-7 and 9-11

The Examiner has rejected claims 1-7 and 9-11 under 35 U.S.C. §103(a) as being unpatentable over US Patent No. 6,268,236 issued to Miyawaki in view of US Patent No. 4,897,508 issued to Mahulikar et al, (hereinafter "Miyawaki" and "Mahulikar" respectively). The Applicant respectfully traverses the rejection.

The test under 35 U.S.C. §103 is not whether an improvement or a use set forth in a patent would have been obvious or non-obvious; rather the test is whether the claimed invention, considered as a whole, would have been obvious. Jones v. Hardy, 110 USPQ 1021, 1024 (Fed. Cir. 1984) (emphasis added). Moreover, the invention as a whole is not restricted to the specific subject matter claimed, but also embraces its properties and the problem it solves. In re Wright, 6 USPQ 2d 1959, 1961 (Fed. Cir. 1988) (emphasis added).

Miyawaki and Mahulikar either alone or in combination fail to teach or suggest the Applicant's invention as a whole. The Applicant respectfully offers that the Examiner has not properly applied the combination of cited references so as to establish the *prima facie* case of obviousness. Specifically, the Examiner identified Miyawaki as allegedly teaching various steps of packaging a component with the exception of disclosing a lid with vent holes. The Examiner then applied alleged teachings of Mahulikar to show a vent hole and the sealing of same in a lid as part of an analogous packaging method and combined the references to show obviousness. It is respectfully submitted that the alleged teachings of Miyawaki do not in fact teach or suggest the various steps as indicated by the Examiner. Therefore, regardless of the specific combination offered, the references are still deficient so as to not render the claims obvious.

Specifically, the Examiner asserts that Miyawaki teaches molding sidewalls 1B onto a substrate to form a plurality of cavities 4 surrounding a component-mounting surface. However, Applicant respectfully submits that such item has not been properly interpreted so as to offer a teaching or suggestion of applicant's claimed specific molding step in independent Claim 1. Miyawaki clearly teaches at Col. 2, line 66 – Col.

11427-1

Response to Office Action
Page 4 of 6

Atty. Dkt. AZMT/002P1
Serial No. : 10/730,758

3, line 1 that the base package substrate 1 is created by adhering ("bonding") a lower first substrate 1A to an upper second substrate 1B rather than molding such upper substrate to form sidewalls. Further, at Col. 3, lines 8-10, the reference teaches, "(t)hrough holes or penetrating holes are formed in the second (upper) substrate 1B in order to produce hollow cavities". This (in the Applicant's view) gives a connotation that the layer 1B is somehow preformed as a sheet and then later punched with holes (or some similar type of construction) to arrive at the final layer. Further still, at Col. 4, lines 54-60, the reference indicates, "...the hollow package can yield the same productivity and cost as those yielded by a mold package while maintaining the advantage of hollow package structure in terms of high-frequency characteristics. Particularly, productivity relating to a sealing process can be significantly improved as compared with that yielded by the conventional mold package". It is submitted that this portion of the reference in fact *teaches away* from molding sidewalls as part of a viable solution to the packaging problems associated with the art. As such, it is not possible for the "molding" step of Miyawaki as identified by the Examiner to be a true molding step as claimed in the subject invention.

A similar argument holds for the alleged teachings of Mahulikar. Specifically, by inspection of any of FIGS. 1, 3 or 4 (and the corresponding written descriptions) it is easily determined that Mahulikar teaches fastening a leadframe 16 to a base 12 with a first sealant 28 and subsequently fastening a cover component 14 to the leadframe 16 with a second sealant 26 that has the same composition as the first sealant (see at least Col 3, lines 21-24 and Col. 4, lines 8-12). While on their faces, these Figures may appear to show molded sidewalls, the reference is distinctly teaching nothing more than sealants applied for bonding purposes. As such, it is respectfully submitted that one skilled in the art would not be led by the combination of cited references to create a molded package in the manner claimed.

Accordingly, the combination of Miyawaki and Mahulikar does not teach, disclose or suggest the invention of independent Claim 1; thus, the combination does not obviate the subject invention as claimed. As such, the Applicant submits that Claim 1 is not obvious and fully satisfies the requirements of 35 U.S.C. §103 and is patentable

11427-1

Response to Office Action
Page 5 of 6

Atty. Dkt. AZMT/002P1
Serial No. : 10/730,758

thereunder. Furthermore, Claims 2-7 and 9-11 depend either directly or indirectly from independent Claim 1 and recite additional features thereof. As such and at least for the same reasons as discussed above, Applicant submits that the dependent claims are also not obvious and fully satisfies the requirements of 35 U.S.C. §103 and are patentable thereunder. Therefore, the Applicant respectfully requests that the Examiner's rejection be withdrawn.

Rejection of Claims under 35 U.S.C. § 103 – Claim 8

The Examiner has rejected Claim 8 under 35 U.S.C. §103(a) as being unpatentable over Miyawaki and Mahulikar in further view of US Patent No. 5,776,799 issued to Song (hereinafter "Song"). The Applicant respectfully traverses the rejection. Specifically, Applicant has hereinabove presented the deficiencies in the teachings and combination of Miyawaki and Mahulikar. It is respectfully submitted that Song does not close the substantial gap in the cited references to support a finding of obviousness to the subject invention. That is, forming an adhesive layer by screen printing does not (either alone or in combination with the other cited references) teach or suggest a packaging method step of molding sidewalls onto a substrate to form a plurality of cavities as claimed. As such and at least for the same reasons as discussed above, Applicant submits that dependent claim 8 is not obvious and fully satisfies the requirements of 35 U.S.C. §103 and is patentable thereunder. Therefore, the Applicant respectfully requests that the Examiner's rejection be withdrawn.

Conclusion

Thus, the Applicant submits that Claims 1-11 are in condition for allowance. Accordingly, both reconsideration of this application and its swift passage to issue are earnestly solicited.

If, however, the Examiner believes that there are any unresolved issues requiring adverse final action in any of the claims now pending in the application, it is requested

11427-1

Response to Office Action
Page 6 of 6

Atty. Dkt. AZMT/002P1
Serial No. : 10/730,758

that the Examiner telephone Mr. Raymond R. Moser, Jr., Esq. at (732) 935-7100 so that appropriate arrangements can be made for resolving such issues as expeditiously as possible.

Respectfully submitted,



~~Raymond R. Moser, Jr., Attorney for Applicant~~
Registration No. 34,682
MOSER IP LAW GROUP
1040 Broad St.
Shrewsbury, NJ 07702
Telephone: (732) 935-7100
Facsimile: (732) 935-7122

11427-1